



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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**EX PARTE Hickman et al.**

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**Application for Patent**

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**Technology Center 2100**

**FOR: SYSTEM AND METHOD  
FOR ELECTRONIC MESSAGE NOTIFICATION**

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**APPEAL BRIEF (NEW)**

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TABLE OF CONTENTS

	<u>Page No.</u>
I. REAL PARTY IN INTEREST .....	1
II. RELATED APPEALS AND INTERFERENCES .....	1
III. STATUS OF THE CLAIMS .....	1
IV. STATUS OF THE AMENDMENTS .....	1
V. SUMMARY OF THE INVENTION .....	1
VI. ISSUES .....	4
A. Did the Examiner make a proper objection to the drawing? .....	4
B. Are claims 1, 3-5, 7, 9, 11-14 and 16-18 properly rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent No. 5,930,471) in view of Ariyama et al. (JP Patent No. 4,111,43936)? .....	4
VII. GROUPING OF THE CLAIMS .....	4
A. Group 1, Claims 1 and 5, stand or fall with claim 1; and .....	4
B. Group 2, Claims 9 and 12, stand or fall with claim 9; .....	4
C. Group 3, Claim 14 and 17, stand or fall with claim 14. ....	4
VIII. THE CITED ART .....	4
A. Milewski et al. (US Patent No. 5,930,471) .....	4
B. Ariyama et al. (JP Patent No. 4,111,43936) .....	5
IX. ARGUMENTS .....	5
A. The Examiner made improper objections to the drawing .....	5
B. Claims 1, 3-5, 7, 9, 11-14 and 16-18 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent No. 5,930,471) in view of Ariyama et al. (JP Patent No. 4,111,43936) .....	6
X. CONCLUSION .....	15

I. REAL PARTY IN INTEREST

The real parties in interest is HSC Venture Fund 1999, the assignee of record.

II. RELATED APPEALS AND INTERFERENCES

Applicant does not believe that there are any related appeals or interferences.

III. STATUS OF THE CLAIMS

All pending claims stand rejected by the Examiner.

IV. STATUS OF THE AMENDMENTS

The Examiner made a final rejection of the claims in an Office Action dated 11/24/03. No amendments after final rejection have been made by Applicant.

V. SUMMARY OF THE INVENTION

The invention relates generally to calendaring systems, and more particularly to docketing systems for law firms and the like. More particularly, embodiments of the invention take a report generated by a docketing program, saves it to disk, parses and filters the saved report, and generates an e-mail notification for a designated recipient. Various embodiments will be discussed below, with exemplary references to the figures and corresponding descriptions, without limitation or estoppel as to the true spirit and scope of the present invention.

In an embodiment of the present invention a method for electronic mail notification starts with the determination (302) that it is a time for at least one of a reminder notification action and a report notification action. If so, a docketing program is opened, and a report is generated by the docketing program. This report is then saved, e.g. to hard disk, for further processing. If it is determined that there is to be a reminder notification action, all action items within a given range

are obtained (304) from the saved report and are processed into at an action item report, which is e-mailed to a designated recipient (306). If it is determined that there is to be a report notification action, a list of completed action items in a given range is obtained from the saved report (308) and processed into a completed action report and e-mailed a designated recipient (310). In one alternate embodiment, processing the action items includes first reading the saved report (e.g. from the hard disk) into memory (502), parsing the report into items (506), and filtering out unwanted items (510). In another alternate embodiment, obtaining a list of completed action items includes reading the report into memory (502), parsing the report into items (506), and creating a list from the items (512). *See*, for example, Figs. 3-5 and page 9, line 4 to page 13, line 15 of the specification.

In another embodiment of the present invention, a system for electronic mail notification includes means determining (5, 20, 302) that it is a time for at least one of a reminder notification action and a report notification action, means for opening (5, 20, 402) a docketing program, means for running a report (5, 20, 404, 406), and means for saving the report for further processing (5, 20, 408). For a reminder notification action, the embodiment further includes means for obtaining (5, 20, 304) all action items within a given range from the report and for processing (5, 20, 306) the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient. For a report notification action, the embodiment further includes means (5, 20, 308) for obtaining a list of completed action items in a given range from the report and processing (5, 20, 310) the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient. *See*, for example, Figs. 1-4 and page 7, line 9 to page 12, line 6 of the specification.

Another embodiment of the present invention includes determining that it is a time for a reminder notification (302), opening a docketing program (402), running a report (404, 406), and saving the report (408), e.g. to a hard disk, for further processing. The embodiment further includes obtaining all action items (304) within a given range from the report and processing the action items (306) into at least one action item report, and e-mailing the at least one action item report (306) to at least one designated recipient. In an alternate embodiment, processing the action items includes reading the saved report into memory (502), parsing the report into items

(506), and filtering out unwanted items (510). *See*, for example, Figs. 3-5 and page 9, line 4 to page 13, line 15 of the specification.

In another embodiment, a system for electronic mail reminders includes means determining that it is a time for a reminder notification, means for opening (5, 20, 402) a docketing program, means for running (5, 20, 404, 406) a report, and means for saving the report (5, 20, 408) for further processing. The system further includes means obtaining (5, 20, 304) all action items within a given range from the report and processing the action items into at least one action item report (5, 20, 306), and means e-mailing (5, 20, 306) the at least one action item report to at least one designated recipient. *See*, for example, Figs. 1-4 and page 7, line 9 to page 12, line 6 of the specification.

In another embodiment, a method for electronic mail reporting includes determining that it is a time (302) for a report notification, opening a docketing program (402), running a report (404, 406), saving the report for further processing (408), obtaining a list (308) of completed action items in a given range from the report and processing (310) the list of completed action items into at least one completed action report, and e-mailing (310) the at least one completed action report to at least one designated recipient. In alternative embodiment, processing the action items includes reading the report into memory (502), parsing the report into items (506), and creating a list (512, 514) from the items. *See*, for example, Figs. 3-5 and page 9, line 4 to page 13, line 15 of the specification.

In another embodiment, a system for electronic mail reporting includes means determining that it is a time (5, 20, 302) for a report notification, means opening a docketing program (5, 20, 402), means running a report (5, 20, 406), means saving the report (5, 20, 408) for further processing, means obtaining a list (5, 20, 308) of completed action items in a given range from the report and processing (310) the list of completed action items into at least one completed action report, and means e-mailing (5, 20, 310) the at least one completed action report to at least one designated recipient. *See*, for example, Figs. 1-4 and page 7, line 9 to page 12, line 6 of the specification.

## VI. ISSUES

The issues presented in this appeal is whether the objection to the drawings and the rejection of the claims as set forth by the Examiner is proper. The issues are therefore:

- A. Did the Examiner make a proper objection to the drawing?
- B. Are claims 1, 3-5, 7, 9, 11-14 and 16-18 properly rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent No. 5,930,471) in view of Ariyama et al. (JP Patent No. 4,111,43936)?

## VII. GROUPING OF THE CLAIMS

Applicant proposes that each of the claims stand or falls on its own, with the exception of the following two groups of claims to stand or fall together:

- A. Group 1, Claims 1 and 5, stand or fall with claim 1; and
- B. Group 2, Claims 9 and 12, stand or fall with claim 9;
- C. Group 3, Claim 14 and 17, stand or fall with claim 14.

## VIII. THE CITED ART

- A. Milewski et al. (US Patent No. 5,930,471)

Milewski et al. (US Patent No. 5,930,471), hereafter referred to as "Milewski" teaches a communications system that facilitates transactions between a sender and a plurality of recipients as part of an electronic messaging system. Messaging means enable a sender to form an electronic template containing a message in the form of a structured response object for a recipient as part of a transaction between a sender and a recipient(s). Controller means receive and store the message in a virtual mailbox assigned to the transaction for access by the sender and the recipient(s). The controller means generate and send to the recipients an indicator or pointer identifying the message at an address for the virtual mailbox. The recipient(s) use the pointer address to view the electronic message in the form of a structured object response at the

virtual mailbox in the controller. The recipient may ignore or file the message or send a response to the virtual mailbox. The response or lack of response to the structured object response by the recipient (s) is tracked and recorded by the controller. The status of the transaction is updated as reflected by the structured object response(s) and summarized for display by the controller upon inquiry by the sender. A reminder of a response due to a transaction is sent by the controller to the recipient(s) when selected from the summary display by the sender. When the transaction between the sender and recipient(s) ends, for one reason or another, the electronic message is erased from the virtual mailbox. This reference would appear to be prior art under 35 U.S.C. 102(e) only, and Applicant reserves the right to swear behind this reference at a future date.

B. Ariyama et al. (JP Patent No. 4,111,43936)

Ariyama et al. (JP Patent No. 4,111,43936), hereafter referred to as "Ariyama" is an untranslated Japanese patent provided with a two paragraph abstract written in English. The first paragraph labeled "PROBLEM TO BE SOLVED" reads that the invention is directed to providing a schedule management device which can effectively supply schedule reminding notifications to a user. The second paragraph labeled "SOLUTION" indicates that the "reminding notification condition" that is previously set for a user is managed at a notification management part 5, and that the notification contents of the schedule information included in a notification period that is coincident with the reminding notification condition are edited at an editing part 6. An execution part 7 via an output part 3 provides a notification means such as a FAX terminal 14, electronic mail terminal 15, etc. This reference would appear to be potential prior art under 35 U.S.C. 102(a) only, and Applicant reserves the right to swear behind this reference at a future date.

IX. ARGUMENTS

A. The Examiner made improper objections to the drawing

The Examiner objected to the drawings "because they fail to show necessary textual labels of features or symbols in Figs. 1-12 as described in the specification." Applicant respectfully traverses, and believes that his drawings fully meet the requirements of 35 U.S.C.

113 and 37 C.F.R. 1.83 and 1.84. In the view of most examiners, numbered elements are preferred over descriptive labels or including "a table next to the present figure..."

Applicant respectfully requests that the Examiner's objections to the drawings be withdrawn as being arbitrary, unnecessary and bureaucratic. Should the Board of Appeals and Interferences sustain the Examiner's objections, Applicant will modify the drawings as suggested by the Examiner.

- B. Claims 1, 3-5, 7, 9, 11-14 and 16-18 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent No. 5,930,471) in view of Ariyama et al. (JP Patent No. 4,111,43936)

As argued separately below, Applicant believes that all pending claims are patentable over Milewski in view of Ariyama.

1. Group 1, Claims 1 and 5

Claim 1 is representative of Group 1. In claim 1 Applicant claims a method for electronic mail notification for a reminder notification, a report notification, or both. For either type of notification, claim 1 requires a determination that it is time for at least one notification, the opening of a docketing report, and the saving of the report for further processing. For a reminder notification action, all action items within a given range are obtained from the saved report and are processed to create at least one action item report with is e-mailed to at least one designated recipient. For a report notification action, a list of completed action items in a given range is obtained from the saved report and is processed into a completed action report, which is e-mailed to at least one designated recipient.

The Examiner cites extensively from Milewski to support his assertion that the prior art meets the limitations of claim 1. Applicant will show that the quotations made by the Examiner are misrepresented and out of context. For example, the Examiner finds the limitation of "opening a docketing program" in Milewski at Fig. 7, col. 8, lines 30-37. The entire paragraph of Milewski is reproduced below:

**In FIG. 7, a message transaction is started in an operation 701 in which a sender uses the processor 30 at station 14 to access the controller 12**



using conventional stored program instructions in the memory 34 for electronically linking the station 14 and the controller 12. As a part of accessing the controller, the sender identifies a structured object response template, previously prepared by the sender and stored in the controller. Milewski, col. 8, lines 29-37.

This quotation from Milewski appears to have no relationship to opening a docketing program, nor does Fig. 7. Further, the Examiner indicates that "running a report" can be found at Fig. 8, col. 9, lines 16-25 and Table 5. The quotation from the specification can be found below:

**In an operation 805, the recipient completes and returns the reply form to the controller. The controller in an operation 809 updates the action message according to the responses or lack of responses received from the recipients. Optionally, the server updates the message content: either the message body 206 or the structured response objects. Table 4 lists pseudo code executable by the controller for updating the action message according to the responses or lack of responses by the recipients. Milewski, col. 9, lines 16-25**

Applicant cannot find any support for the Examiner's assertion that "running a report" can be found in the above quotation. Furthermore, the Examiner's reference to "Table 5" is virtually meaningless. Table 5 is reproduced below:

**Table 5, Controller displays reply info to sender**  
get MESSAGE.sub.-- ID from inquiry form;  
open.sub.-- file MESSAGE.sub.-- ID for reading;  
read (SUBJECT, QUESTION) from file MESSAGE.sub.-- ID;  
print SUBJECT, QUESTION;  
read (POSSIBLE.sub.-- RESPONSES) from file MESSAGE.sub.-- ID;  
print POSSIBLE.sub.-- RESPONSES;  
read (RECIPIENTS) from file MESSAGE.sub.-- ID;  
read (RESPONSES) from file MESSAGE.sub.-- ID;  
RESPONSE.sub.-- COUNTS = 0;  
NOT.sub.-- RESPONDED = (empty);  
RESPONSES = (empty);  
for each RECIP (RECIPIENTS) {  
  if (RECIP in RESPONSES) {  
    THIS.sub.-- RESP = RESPONSES ›RECIP!;  
    RESPONSE.sub.-- COUNT ›THIS.sub.-- RESP!++;  
  } else {  
    append RECIP to NOT.sub.-- RESPONDED;  
  }  
}  
for each RESP (RESPONSES) {  
  print RESP, RESPONSE.sub.-- COUNT ›RESP!;  
}

```

for each RECIP (RECIPIENTS) {
  if (RECIP not in NOT RESPONDED) {
    print RECIP, RESPONSES >RECIP!;
  }
}
if (NOT.sub.-- RESPONDED is not empty) {
  print "Not yet answered:";
  for each RECIP (NOT.sub.-- RESPONDED) {
    print RECIP;
  }
  insert button (label="Send reminder message",
    action="reminder",
    MESSAGE.sub.-- ID, NOT.sub.-- RESPONDED);
}
close.sub.-- file MESSAGE.sub.-- ID;

```

Applicant fails to find the relevance of the above quotation to his claim limitation of "running a report." As to "saving the report for further processing", the Examiner cites the following language:

**... receiver station 14". Processor 18 is coupled through a system bus 20 to a conventional system memory 22; a magnetic storage DASD (Direct Access Storage Device) 24 which serves as storage for application programs executed by the processor 18, and an interface 26 linking the processor with the station 14' for information transfer purposes. The memory 22 contains stored program instructions for a conventional operating system linking together the units 22, 24 and 26 as a communications controller. The memory 22, from time to time, obtains applications programs in the form of program instructions from the disk 24 to implement communication protocols in exchanging messages among the stations 14'. The details of these stored program instructions will be described hereinafter in connection with the operation of the communications system. Also, the memory 22 and disk 26 store electronic templates of structured object responses prepared by senders at the communications stations 14' as part of a transaction with one or more recipients. Milewski, col. 6, lines 2-19.**

This quotation from Milewski seems to be totally unrelated to either a docketing program report, or the saving of a docketing program report for further processing. The Examiner then cites "for a reminder notification action, obtaining all action items within a given ranges and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient" as disclosed in Fig. 6 and in the following quotation:

**...who have not answered the message. A field 612 sends a reminder message to the recipient in field 610 by the sender clicking on the field 612. A field 614**

**deletes the message from the controller when the sender clicks on the field 614. Milewski, col. 8, lines 21-24.**

Neither Fig. 6 nor the above quotation are even vaguely related to the claim limitation referred to by the Examiner. That is, there is no hint of obtaining all action items in a given range, processing them into an action item report, or e-mailing the report to a recipient. The Examiner asserts that the limitation "for a report notification action, obtaining a list of completed action items in a given range and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient" is taught at Fig. 6 and in the following quotation:

**FIG. 6 is a screen of a transaction summary form 600 prepared by the controller and indicating the status of the message distributed to the recipients in template 200. A field 602 repeats the text in field 206 of template 200. A field 603 opens or limits responses according to fields 214 or 216 in FIG. 2. A field 604 indicates the allowed responses to the field 206 based upon the authorized responses in field 208 of template 200. A field 606 is a response count and type of response provided by the recipients of the message as listed in field 202 of template 200. The individual responses to the message are listed in a field 606. The controller strips the text from the recipient's response and enters it beside his name in the field 608. A field 610 provides a list of recipients who have not answered the message. A field 612 sends a .... Milewski, col. 8, lines 9-21.**

Again Fig. 6 nor the above quotation are even vaguely related to the claim limitation referred to by the Examiner. That is, there is no hint of obtaining a list of completed action items in a given range, processing them into a completed action report, or e-mailing the report to a recipient.

The Examiner then asserts that "Milewski does not explicitly teach determining the time for sending reminder notification." Applicant asserts that Milewski does not implicitly teach this either. The Examiner then refers to Ariyama "at Fig. 1, page 1, paragraph – SOLUTION as meeting this claim limitation." This quotation is as follows:

**SOLUTION: The reminding notification condition that is previously set for a user is managed at a notification management part 5, and the notification contents of schedule information included in a notification period that is coincident with the reminding notification condition are edited at an editing part 6 in the notification period. Then the reminder notification of the contents edited at the part 6 is carried out at an execution part 7 via an output part 3 coincident with the reminding notification condition and a**

**notification means such as a FAX terminal 14, an electronic mail terminal 15, etc. Ariyama, page 1, SOLUTION.**

There is nothing in this quotation from Ariyama or from Fig. 1 to lead the Examiner to the conclusion that Ariyama determines the time for sending the reminder notification. The disclosure of Ariyama is unclear on this matter. When confronted with this, the Examiner provided a "machine translation" of the Japanese reference, which does little to clarify this matter. Applicant respectfully suggests that one of ordinary skill in the art would not believe this reference to include this element, or consider Ariyama combinable with Milewski.

It is therefore clear that the Examiner has not even made a *prima facie* case of obviousness with respect to the claims of Group 1. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). See MPEP , 2142 and 2143 – 2143.03.

First, since neither Milewski nor Ariyama appear to even relate to claim 1, they clearly cannot be said to suggest or motivate one of ordinary skill in the art to create the claimed combination. Second, there is no teaching of the claimed combination, so there can be no reasonable expectation of success. Finally, the prior art references do not teach or suggest all of the claim limitations, as set forth above. Clearly, the claims of Group 1 meet the requirements of 35 U.S.C. 103 with respect to the cited art, and the rejection of these claims was in error and should be reversed.

2. Claim 3

Claim 3 is dependent upon claim 1 and is therefore patentable for at least the same reasons as set forth with respect to Group 1, above. In addition, claim 3 includes further claim limitation not found in either Milewski or Ariyama, as described below.

The Examiner indicated that "reading the saved report into memory" can be found in Fig. 9 and in col. 9, lines 26-29, which is reproduced below:

**In an operation 811, the controller optionally sends notification of recipient responses to the sender. The controller may send notification of every response or may send a notification of only completed transactions. Milewski, col. 9, lines 26-29**

This has no apparent relationship to the reading of a saved report into memory (e.g. from a hard disk into RAM memory). The Examiner then indicated that "parsing the report into items" could be found at Fig. 9, col. 9, lines 35-42:

**Transaction summarizing is started in operation 901 in which the sender obtains from the controller and follows a pointer to the status information related to the transaction contained at the virtual mailbox. In response to the sender inquiry, the controller in an operation 903 displays the current status (complete or incomplete) of messages sent by the sender and messages sent to the sender as shown in FIG. 5. Table 5 lists pseudo code executable by the controller for ... . Milewski, col. 9, lines 35-42.**

There is no teaching of parsing in this quotation from Milewski. Furthermore, Table 5 (reproduced above with respect to the arguments for Group 1) is not a parsing process. A review of the process of Table 5 indicates that it is a subroutine to create a list of non-responders to a previously sent message. There seems to be no relationship to parsing in this pseudocode. Finally, the Examiner indicates the "filtering out unwanted items" can be found in Milewski in Fig. 9, Table 5, and col. 9, line 42 to col. 10, line 11, which is reproduced below:

**Table 5 lists pseudo code executable by the controller for summarizing and displaying the status of response or lack of response by recipients upon inquiry by the sender.**

**In an operation 905, the controller provides the sender upon request with status information as shown in FIG. 6 relative to the reply information received and stored by the controller in the virtual mailbox. The status information may also contain the individual responses from the recipients as indicated in FIG. 6. Table 6 lists pseudo code executable by the controller for**

**summarizing and displaying the status of the responses or lack of responses stored in the virtual mailbox by the controller. Milewski, col. 9, line 42 to col. 10, line 11.**

Again, this quotation from Milewski does not teach filtering. The pseudocode of Table 5 has nothing to do with filtering, and Fig. 9 is unrelated to filtering. More particularly, if Table 5 or Fig. 9 taught filtering, there would necessary be conditional branching and iteration in the pseudocode or flow diagram. No conditional branching or iteration is found in either Table 5 or Fig. 9.

Applicant again asserts that the Examiner has not presented even a *prima facie case* of obviousness with respect to claim 3, and respectfully requests that his rejection be reversed.

3. Claim 4

Claim 4 is dependent upon claim 1 and, therefore is patentable over the cited art for at least the same reasons as set forth with respect to Group 1. Additionally, the "reading" and "parsing" limitations of claim 4 are not found in Milewski for similar reasons as set forth with respect to claim 3, incorporated herein by reference. Still further, the Examiner provided no support for an assertion that the "creating a list from the items" limitation was found anywhere in the prior art. Applicant therefore asserts that claim 4 is patentable over the cited art for these reasons as well, and respectfully requests that the Examiner's rejection be reversed.

4. Claim 7

Claim 7 is to a system for electronic mail notification. It is written in means-plus-function format under 35 U.S.C. 112 ¶6. As such, the function of the elements recited in claim 7 must be identical to the functions found in cited art. *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ 2d 1845 (Fed. Cir. 1994) (en banc). The function recited in claim 7 uses essentially the same language as the process recited in claim 1 and, therefore, the arguments with respect to Group 1 are incorporated herein by reference with respect to the function performed by the system of claim 7. Since the cited art does not include the function, let alone the exact function, of the elements of claim 7, the rejection of this claim fails for that reason alone.

Furthermore, the Examiner has done no analysis of the structures disclosed by Applicant, Milewski and Ariyama to determine if the structures are the same or an equivalent under 35 U.S.C. 112 ¶6.

The Examiner has, once again, failed to make a *prima facie* case of obviousness, and his rejection of claim 7 must be reversed.

5. Group 2, Claims 9 and 12

Claim 9 is representative of this group. This claim has overlap with the arguments with respect to the Group 1 claims, and those arguments are incorporated herein by reference. That is, the Examiner fails to show that Milewski teaches the "opening", "running", "saving", "obtaining" or "e-mailing" acts recited in claim 9, that Ariyama teaches the "determining" act, or that Milewski or Ariyama suggest the combination or are combinable with some chance of success. As such, the Examiner fails to make a *prima facie* case of obviousness with respect to the claims of Group 2, and his rejection of those claims should be reversed.

6. Claim 11

Claim 11 is dependent upon claim 9 and, as such, is patentable for at least the same reasons as set forth with respect to Group 2, above. Furthermore, the limitations of claim 11 are similar to the limitations of claim 3 and, as such, the arguments with respect to claim 3 are incorporated herein by reference. Briefly, the "reading", "parsing" and "filtering" acts are all missing from the cited art. Again, no *prima facie* obviousness has been shown and this rejection should be reversed.

7. Claim 13

Claim 13 is to a system for electronic mail reminders. It is written in means-plus-function format under 35 U.S.C. 112 ¶6. As such, the function of the elements recited in claim 13 must be identical to the functions found in cited art. *In re Donaldson Co.* supra. The function recited in claim 13 uses essentially the same language as the process recited in claim 9 and, therefore, the arguments with respect to Group 2 are incorporated herein by

reference with respect to the function performed by the system of claim 13. Since the cited art does not include the function, let alone the exact function, of the elements of claim 13, the rejection of this claim fails for that reason alone. Furthermore, the Examiner has done no analysis of the structures disclosed by Applicant, Milewski and Ariyama to determine if the structures are the same or an equivalent under 35 U.S.C. 112 ¶6.

The Examiner has again failed to make a *prima facie* case of obviousness, and his rejection of claim 13 must be reversed.

8. Group 3, Claims 14 and 17

Claim 14 is representative of this group. This claim has overlap with the arguments with respect to the Group 1 and Group 2 claims, and those arguments are incorporated herein by reference. That is, the Examiner fails to show that Milewski teaches the "opening", "running", "saving", "obtaining" or "e-mailing" acts recited in claim 14, that Ariyama teaches the "determining" act, or that Milewski or Ariyama suggest the combination or are combinable with some chance of success. As such, the Examiner fails to make a *prima facie* case of obviousness with respect to the claims of Group 3, and his rejection of those claims should be reversed.

9. Claim 16

Claim 16 is dependent on claim 14 and, therefore, is patentable for at least the reasons set forth with respect to Group 3, above. Furthermore, claim 16 has elements similar to those found in claim 4, and those arguments are also incorporated herein by reference. Clearly, the Examiner has not shown the "reading", "parsing" and/or "creating" acts recited in claim 16 and, as such, has not made a *prima facie* case of obviousness. This rejection should be reversed as well.

10. Claim 18

Claim 18 is to a system for electronic mail reminders. It is also written in means-plus-function format under 35 U.S.C. 112 ¶6. As such, the function of the elements recited in claim 18 must be identical to the functions found in cited art. *In re Donaldson Co.*



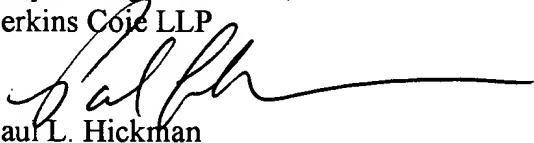
supra. The function recited in claim 18 uses essentially the same language as the process recited in claim 14 and, therefore, the arguments with respect to Group 3 are incorporated herein by reference with respect to the function performed by the system of claim 18. Since the cited art does not include the function, let alone the exact function, of the elements of claim 18, the rejection of this claim fails for that reason alone. Furthermore, the Examiner has done no analysis of the structures disclosed by Applicant, Milewski and Ariyama to determine if the structures are the same or an equivalent under 35 U.S.C. 112 ¶6.

The Examiner has, once again, failed to make a prima facie case of obviousness, and his rejection of claim 18 must be reversed.

#### X. CONCLUSION

As noted above, the objections to the drawings made by the Examiner were either made to discretionary matters or were in error, and should be rescinded. With respect to the rejections in view of the prior art, neither of the cited art references, either alone or in combination, can be said to render obvious the appealed claims. Accordingly, Applicant believes the rejections to be in error, and respectfully requests the Board of Appeals and Interferences to reverse the Examiner's objections and rejections.

Respectfully Submitted,  
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## **APPENDIX A - THE APPEALED CLAIMS**

1. A method for electronic mail notification comprising:

determining that it is a time for at least one of a reminder notification action and a report notification action;

opening a docketing program;

running a report;

saving the report for further processing;

for a reminder notification action, obtaining all action items within a given range from said report and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient; and

for a report notification action, obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient.

3. A method for electronic mail notification as recited in claim 1 wherein processing the action items includes:

reading the saved report into memory;

parsing the report into items; and

filtering out unwanted items.

4. A method for electronic mail notification as recited in claim 1 wherein obtaining a list of completed action items includes:

reading the report into memory;

parsing the report into items; and

creating a list from the items.

5. A computer readable media including code segments for electronic mail notification comprising:

a code segment determining that it is a time for at least one of a reminder notification action and a report notification action;

a code segment opening a docketing program;

a code segment running a report;

a code segment saving the report for further processing

for a reminder notification action, a code segment obtaining all action items within a given range from said report and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient; and

for a report notification action, a code segment obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient.

7. A system for electronic mail notification comprising:

means determining that it is a time for at least one of a reminder notification action and a report notification action;

means for opening a docketing program;

means for running a report;

means for saving the report for further processing;

for a reminder notification action, means for obtaining all action items within a given range from said report and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient; and

for a report notification action, means for obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient.

9. A method for electronic mail reminders comprising:

determining that it is a time for a reminder notification;

opening a docketing program;

running a report;

saving the report for further processing;

obtaining all action items within a given range from said report and processing the action items into at least one action item report; and

e-mailing the at least one action item report to at least one designated recipient.

11. A method for electronic mail reminders as recited in claim 9 wherein processing the action items includes:

reading the saved report into memory;

parsing the report into items; and

filtering out unwanted items.

12. A computer readable media including code segments for electronic mail reminders comprising:

a code segment determining that it is a time for a reminder notification;

a code segment opening a docketing program;

a code segment running a report;

a code segment saving the report for further processing;

a code segment obtaining all action items within a given range from said report and processing the action items into at least one action item report; and

a code segment e-mailing the at least one action item report to at least one designated recipient.

13. A system for electronic mail reminders comprising:

means determining that it is a time for a reminder notification;

means for opening a docketing program;

means for running a report;

means for saving the report for further processing;

means obtaining all action items within a given range from said report and processing the action items into at least one action item report; and

means e-mailing the at least one action item report to at least one designated recipient.

14. A method for electronic mail reporting comprising:

determining that it is a time for a report notification;

opening a docketing program;

running a report;

saving the report for further processing;

obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report; and

e-mailing the at least one completed action report to at least one designated recipient.

16. A method for electronic mail reporting as recited in claim 14 wherein processing the action items includes:

reading the report into memory;

parsing the report into items; and

creating a list from the items.

17. A computer readable media including code segments for electronic mail reporting comprising:

a code segment determining that it is a time for a report notification;

a code segment opening a docketing program;

a code segment running a report;

a code segment saving the report for further processing;

a code segment obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report; and

a code segment e-mailing the at least one completed action report to at least one designated recipient.

18. A system for electronic mail reporting comprising:

means determining that it is a time for a report notification;

means opening a docketing program;

means running a report;

means saving the report for further processing;

means obtaining a list of completed action items in a given range from said report and processing the list of completed action items into at least one completed action report; and

means e-mailing the at least one completed action report to at least one designated recipient.